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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,649	09/13/2002	Aws Nashef	8830-27	3544

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DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

EXAMINER

GIBSON, ROY DEAN

ART UNIT PAPER NUMBER

3739

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,649

Applicant(s)

NASHEF ET AL.

Examiner

Roy D. Gibson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 18 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Formal Matters

The allowability of claims 17, 18, 27, 28 and 31-32 are withdrawn in light of newly found prior art.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 recites the limitation "outer wall" in line 3. There is insufficient antecedent basis for this limitation in the claim. The examiner suggests inserting "an outer" in place of "a" after "and" in line 1 to correct this.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Sramek (4,836,214). Sramek discloses a catheter (hollow flexible tube # 10) having a distal end and an outer wall (12), the catheter comprising a heat transfer device

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(electrode 30) located approximately at its distal end, wherein the heat transfer device is a length of the outer wall of the catheter at least partly formed from doped material (formed by impregnating the wall 12 of the tube with a conductive material) able to act as a heat transfer device upon application of power therethrough (Figures 2 and 4 and col. 4, line 57-col. 5, line 65). Further to claim 31, Sramek discloses the tube has a hollow inner portion (single lumen) for the wires for the electrodes (col. 3, lines 35-48).

Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Spencer (5,037,395). Spencer discloses a catheter (10) having a distal end and a wall, the catheter comprising a heat transfer device (thin film heater 34) located approximately at its distal end, wherein the heat transfer device is a flexible metal film having at least one electrical resistor flow path therethrough, wherein said film is locatable around the catheter wall, and wherein the heat transfer device comprises an outwardly located layer of silver or gold, the catheter having a single lumen to drain urine from the bladder (col. 1, lines 5-46, col. 2, line 30-col. 4, line 15, see specifically col. 3, lines 25-27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sramek.

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Sramek fails to specifically disclose the conductive material used for impregnating the wall of the tube to render the wall electrically and thermally conductive. However, the examiner maintains that numerous examples in the art disclose the use of gold or silver for similar applications because of their thermal and electrical conductivity and biocompatibility with the fluids, etc, of the human body.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer. Although Spencer fails to specifically disclose the diameter of the catheter to be between approximately 0.5 and 0.7 mm, the examiner maintains it would have been obvious to one of ordinary skill in the art of medical catheters to size the catheter appropriately for the application and that 0.5 and 0.7 mm diameter would be appropriate for insertion into the urethra (disclosed by Spencer). Also the size alone of a device is generally not a patentable feature as detailed in MPEP 2144.04 IV A.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sramek. Although Sramek fails to specifically disclose the diameter of the catheter to be between approximately 0.5 and 0.7 mm, the examiner maintains it would have been obvious to one of ordinary skill in the art of medical catheters to size the catheter appropriately for the application. Also the size alone of a device is generally not a patentable feature as detailed in MPEP 2144.04 IV A.

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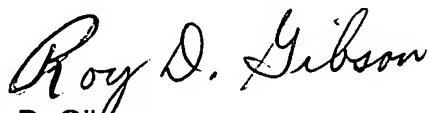
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Norris (5,634,470) discloses a system for monitoring and controlling the temperature of a catheter-mounted heater wherein the heater is configured as a flexible metallic film element (col. 5, lines 4-22).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 571-272-4767. The examiner can normally be reached on Tu-Th, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Roy D. Gibson
Primary Examiner
Art Unit 3739

November 3, 2005